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2003-03-03 08:00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEU.S. PATENT AND TRADEMARK
OFFICEIn re Application of:
Tom Tomlin

Serial No.: 10/046,948

Filed: 01/14/2002

Group Art Unit: 3632

Examiner: Brann

Subject: TRASH BAG SUPPORT AND
LINER

Attorney Docket: TOMT101

**REQUEST FOR REFUND UNDER 37 C.F.R. §1.28(a)
For Paying Large Entity Fee in Error**

TO: Commissioner of Patents and Trademarks
Office of Finance
Refund Section
Box 16
Washington, DC 20231

Dear Commissioner:

A Petition for Revival of Application for Patent Abandoned Unavoidably Under 37 CFR 1.137(a) was filed in the above-referenced case on November 17, 2003 (copy enclosed). The applicant was entitled to small entity status and claimed such. The fees in the amount of \$110.00 were paid with firm check number 13727. However, upon closer review of the file, Applicant's attorney of record noted that the USPTO fee was, in reality, \$55.00 for the Petition.

Adjustment date: 03/09/2004 SDIRETAI
11/21/2003 AWONDAFI 00000103 10046948
01 FC:1452 -110.00 OP

03/09/2004 SDIRETAI 00000003 10046948
01 FC:2452 55.00 OP REQUEST FOR REFUND - Page 1 of 2

Refund Ref: 03/09/2004 SDIRETAI 0000134594 M.E.

CHECK Refund total: -\$55.00

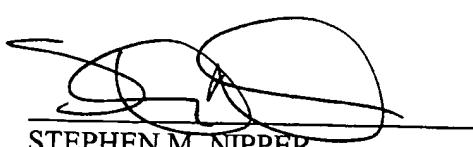
PATENT AND TRADEMARK
REFUND REQUEST

As such, Applicant respectfully requests under §1.28(a) that filing fees in the amount of \$55.00 be refunded.

DATED this 3 day of December 2003.

US PATENT & TRADEMARK
REFUND REQUEST

Very respectfully,

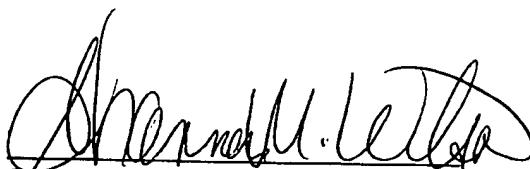


STEPHEN M. NIPPER
Reg. No. 46,260
(208) 345-1122

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Office of Finance, Refund Section, Box 16, Washington, DC 20231.

DATE: 12/13/03



Shannon M. Wilson

SEARCHED 10/17/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEU.S. PATENT AND TRADEMARK
OFFICEIn re Application of:
Tom Tomlin

Group Art Unit: 3632

Serial No.: 10/046,948

Examiner: Brann

Filed: 01/14/2002

Subject: TRASH BAG SUPPORT AND
LINER

Attorney Docket: TOMT101

**REQUEST FOR REFUND UNDER 37 C.F.R. §1.28(a)
For Paying Large Entity Fee in Error**

TO: Commissioner of Patents and Trademarks
Office of Finance
Refund Section
Box 16
Washington, DC 20231

Dear Commissioner:

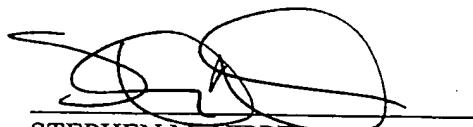
A Petition for Revival of Application for Patent Abandoned Unavoidably Under 37 CFR 1.137(a) was filed in the above-referenced case on November 17, 2003 (copy enclosed). The applicant was entitled to small entity status and claimed such. The fees in the amount of \$110.00 were paid with firm check number 13727. However, upon closer review of the file, Applicant's attorney of record noted that the USPTO fee was, in reality, \$55.00 for the Petition.

PATENT AND TRADEMARK
USPTO - U.S. GOVERNMENT

As such, Applicant respectfully requests under §1.28(a) that filing fees in the amount of \$55.00 be refunded.

DATED this 3 day of December 2003.

Very respectfully,



STEPHEN M. NIPPER
Reg. No. 46,260
(208) 345-1122

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Office of Finance, Refund Section, Box 16, Washington, DC 20231.

DATE: 12/3/03



Shannon M. Wilson

TRANSMITTAL LETTER
(General - Patent Pending) PATE

Docket No.
TOMT101

In Re Application Of: TOMLIN

2003-01-17 09:53

COPY

Serial No.
10/046,948

Filing Date
01/14/2002

USPTO
Examiner
BRANN

Group Art Unit
3632

Title: TRASH BAG SUPPORT AND LINER

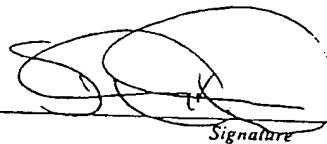
TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith is:

LETTER FROM STEPHEN M. NIPPER PETITION FOR REVIVAL OF APPLICATION...UNAVOIDABLY...
5 PAGES OF CORRESPONDENCE BETWEEN FORMER COUNSEL AND APPLICANT
DOC. ENTITLED "REASONS WHY MY PATENT APPLICATION WENT ABANDONED"
RESPONSE TO OFFICE ACTION DATED 10/09/02 REVOCATION OF POWER OF ATTORNEY
RETURN RECEIPT POST CARD POWER OF ATTORNEY

in the above identified application.

- No additional fee is required.
- A check in the amount of \$110.00 is attached.
- The Director is hereby authorized to charge and credit Deposit Account No. as described below.
 - Charge the amount of
 - Credit any overpayment.
 - Charge any additional fee required.

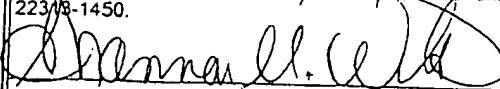


Signature

Dated: 11/14/03

STEPHEN M. NIPPER
DYKAS, SHAVER & NIPPER, LLP
PO BOX 877
BOISE, ID 83701-0877
208-345-1122
REG. NO. 46,260
CUST. NO. 21,658

I certify that this document and fee is being deposited on 11/17/03 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Signature of Person Mailing Correspondence

SHANNON M. WILSON

Typed or Printed Name of Person Mailing Correspondence

CC: CLIENT

DYKAS, SHAVER & NIPPER

208 345 8370

11/14/03 02:36pm P. 002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
POWER OF ATTORNEY

Docket No.
TOMT101

Name of Applicant: **TOMLIN, TOM**
Address of Applicant: **10903 MUSKET STREET**
BOISE, IDAHO 83713

Title: **TRASH BAG SUPPORT WITH LINER**Serial No., If Any: **10/046,948**
Filed: **01/14/2002**

TO THE COMMISSIONER FOR PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Sir:
I hereby appoint:

STEPHEN M. NIPPER

as principal attorneys to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

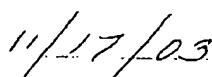
Please direct all future correspondence to:

STEPHEN M. NIPPER
DYKAS, SHAVER & NIPPER, LLP
P.O. BOX 877
BOISE, IDAHO 83701
(208)345-1122

By:



Dated:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
REVOCATION OF POWER OF ATTORNEY

Docket No. US PTM 10 10000000000000000000
TOMT10

Name of Applicant: **TOMLIN, TOM**
Address of Applicant: **10903 MUSKET STREET**
BOISE, IDAHO 83713

Title: **TRASH BAG SUPPORT WITH LINER**

Serial No., if Any: **10/046,948**
Filed: **01/14/2002**

TO THE COMMISSIONER FOR PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Sir:

I hereby revoke the Power of Attorney given to:

KEN PEDERSEN
BARBARA PEDERSEN

Dated:

11/17/03

By:

Tom Tomlin

DYKAS, SHAVER & NIPPER, LLP

PATENT TRADEMARK COPYRIGHT INTERNATIONAL

FRANK J. DYKAS
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STEPHEN M. NIPPER
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DEREK H. MAUGHAN
Registered Patent Attorney
maughan@dykaslaw.com

November 14, 2003

Attention: Office of Petitions
Mail Stop Petitions
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Serial Number 10/046,948
TRASH BAG SUPPORT AND LINER
Filed: 01-14-2002
Our File: TOMT101

Dear Commissioner:

My name is Stephen M. Nipper. I am a registered patent attorney who has been hired by the Applicant, Mr. Tomlin, to review his patent application file. It is my opinion, based upon the facts that I know, that Mr. Tomlin's patent application was unavoidably abandoned.

It appears that Mr. Tomlin had a variety of circumstances which came together when the application went abandoned. According to what he has told me, between the ineffective assistance of his prior patent counsel in explaining the patenting process to him and a series of health issues, Mr. Tomlin's application went unavoidably abandoned.

It is my understanding that Mr. Tomlin was charged by his prior patent attorney \$2,600.00 (plus the filing fee) for the preparation and filing of the original 5-pages long provisional application. Then, one year later, Mr. Tomlin was charged \$1,600.00 (plus the filing fee), to write the application's four claims and file the application as a non-provisional patent application (totaling 6-pages long). The provisional application is substantially a duplicate of the nonprovisional application minus the claims.

At the time of receipt of the Office Action, Mr. Tomlin had \$1,030.00 held in his prior patent attorney's trust account. Regardless of this fact, his prior counsel still asked for an additional retainer of \$600.00 before work would begin in preparing a Response. Mr. Tomlin indicated to me that he had thought that he had indicated to his prior counsel to begin preparation and filing of a Response. However, on April 2, 2003, Mr. Tomlin received a letter from his prior counsel indicating that Mr. Tomlin had "chosen to discontinue your current 'Trash Bag Support Liner' project", enclosing therewith a check for the \$1,030.00, which had been held in trust.

At the time of receipt of his prior counsel's April 2, 2003 letter, Mr. Tomlin and his wife were undergoing a number of medical operations and were suffering financial problems therefrom. As such, Mr. Tomlin felt he was financially, physically, and emotionally unable to further deal with his prior counsel. Upon recovering from his medical issues and discussing his project with a friend, he was referred to my office to see if anything could be done with respect to his application.

It is my opinion, based upon my review of the facts, that there was no possible way that Mr. Tomlin could have timely filed a Response preventing the abandonment of the application.

I have reviewed the application prepared and filed by his prior patent attorney and believe that the claims can be substantially rewritten to overcome the Examiner's rejections based upon the prior art. An amendment accomplishing this is enclosed herewith.

I enclose herewith copies of the correspondence between Mr. Tomlin and his prior patent counsel. If further evidence or proof is necessary, please contact me.

Best regards,

STEPHEN M. NIPPER
Registered Patent Attorney

SMN/smw
Enclosures

PEDERSEN & COMPANY, PLLC

PATENT ATTORNEY FIRM

KEN J. PEDERSEN
PATENT ATTORNEY

BARBARA S. PEDERSEN
PATENT AGENT

SCOTT R. CLEERE
ASSOCIATE ATTORNEY

INTELLECTUAL PROPERTY LAW
PATENTS • TRADEMARKS • COPYRIGHTS

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P. O. Box 2666
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E-MAIL: IP@PEDERSENCO.COM
WEBSITE: WWW.PEDERSENCO.COM

STACEY D. COLEMAN
OFFICE MANAGER

US PATENT & TRADEMARK
OFFICE

April 2, 2003

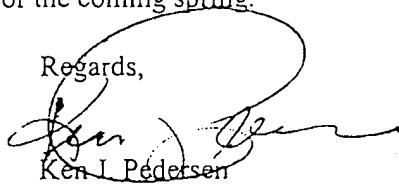
Tom Tomlin
10903 Musket St.
Boise, ID 83713

Dear Tom:

Thank you for choosing Pedersen and Company, PLLC to represent you in your intellectual property matters. We understand that you have chosen to discontinue your current "Trash Bag Support Liner" project, but we look forward to serving you again in the future. Please find enclosed a check in the amount of \$1,030.00 that has been paid from our trust account. As you have chosen not to pursue patent protection for your invention, it will no longer be necessary for us to retain these funds.

In the future, please do not hesitate to contact me in the office with any questions or comments you may have or to discuss new ideas. I can be reached via email at ip@pedersenco.com or by phone at (208)343-6355. Thank you again for this opportunity to work with you. Best wishes for the coming spring.

Regards,



Ken L. Pedersen

enc -

PEDERSEN & COMPANY, PLLC

PATENT ATTORNEY

KEN J. PEDERSEN
PATENT ATTORNEY

INTELLECTUAL PROPERTY LAW
PATENTS • TRADEMARKS • COPYRIGHTS

STACEY D. COLEMAN
OFFICE MANAGER

BARBARA S. PEDERSEN
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US PATENT AND TRADEMARK
OFFICE

SCOTT R. CLEERE
ASSOCIATE ATTORNEY

December 9, 2002

Tom Tomlin
10903 Musket Street
Boise, ID 83713

Re: Patent Application "Trash Bag Support and Liner"
Response to Examiner's Action
Our File No. 2785

Dear Tom:

Please find enclosed a copy of an Examiner's Action sent by the Patent and Trademark Office regarding your subject application.

A Response to this Examiner's Action must be filed by February 9, 2003 (with a one-month extension fee of \$55, which I will pay, because this letter has been delayed in coming to you). This due date may be extended, up to April 9, 2003, upon payment of the appropriate extension fee to the Patent Office (currently, 2 months - \$200.00; 3 months - \$460.00). If no Response is filed on or before April 9, 2003, the patent application will become abandoned.

It is common for the Examiner to reject claims in a patent application in an Examiner's Action. In your Response to an Examiner's Action, you have the right to make amendments to the claims of the patent application and to make arguments regarding the novelty and unobviousness of your invention compared to the "prior art" references and patents cited by the Examiner. Often, even after rejection on an Examiner's Action, we are successful in obtaining an issued patent for inventors by making these amendments and arguments. Therefore, I recommend that you review the enclosed references cited by the Examiner to determine differences between your invention and the apparatus or methods disclosed in the cited references, in order to formulate a strategy for responding the Examiner's Action.

REMINDER

1-8-03

2785. Office Action Letter

As you may recall, we have \$1,030.00 in trust. Therefore there is no need to send a retainer for the preparation of the Response to the Examiner's Action. However, we do need your comments with regard to the Examiner's Action sent to you on December 9. We look forward to receiving your comments as soon as possible.

FILE COPY

PATENT & TRADEMARK OFFICE

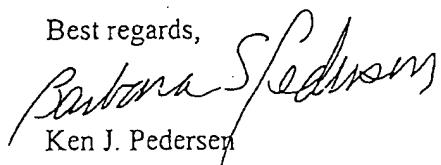
Tom Tomlin
December 9, 2002
Page 2

200 E. FRUITLAND AVE., P.O.

US PATENT & TRADEMARK
OFFICE

My fee for preparing and filing the Response will be at our hourly rate of \$160.00-\$200.00 per hour, and we estimate approximately \$600.00 - \$800.00. If you want to proceed, please send a retainer of \$600 in advance of us preparing the Response. Please call Ken to discuss this Examiner's Action. Thank you.

Best regards,


Barbara S. Pedersen

Barbara S. Pedersen

BSP:cfo

Enclosures

PEDERSEN & COMPANY, PLLC

KEN J. PEDERSEN
PATENT ATTORNEY

BARBARA S. PEDERSEN
PATENT AGENT

SCOTT R. CLEERE
ASSOCIATE ATTORNEY

INTELLECTUAL PROPERTY LAW
PATENTS • TRADEMARKS • COPYRIGHTS

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STACEY D. COLEMAN
OFFICE MANAGER

US PATENT & TRADEMARK
OFFICE

December 9, 2002

Tom Tomlin
10903 Musket Street
Boise, ID 83713

Re: Patent Application "Trash Bag Support and Liner"
Response to Examiner's Action
Our File No. 2785

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Tom Tomlin
December 9, 2002
Page 2

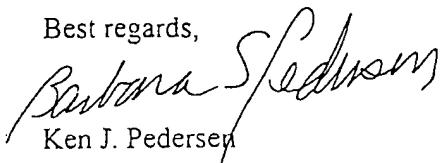
PATENT AND TRADEMARK OFFICE

ATTN: 1737 4323

US PATENT & TRADEMARK
OFFICE

My fee for preparing and filing the Response will be at our hourly rate of \$160.00-\$200.00 per hour, and we estimate approximately \$600.00 - \$800.00. If you want to proceed, please send a retainer of \$600 in advance of us preparing the Response. Please call Ken to discuss this Examiner's Action. Thank you.

Best regards,


Barbara S. Pedersen

Barbara S. Pedersen

BSP:cfo

Enclosures

REASONS WHY MY PATENT APPLICATION WENT ABANDONED

On the day I received the denial of my patent application, I called Ken Pedersen, my patent attorney, and asked him if this document said what I thought it said. He responded that in fact my application was denied but we could appeal that decision. I told him then that I wanted to appeal and we ended our conversation. About three months later I called Mr. Pedersen and asked him what was happening with the appeal. He stated then that he was waiting for me to tell him what I wanted to do. He then told me that an appeal at this point would cost me about \$2,000.00 more. Then, I later received a letter from Mr. Pedersen saying that I had chosen to stop work on the project, returning to me whatever money I had in his trust account. Mr. Pedersen never explained to me about abandonment or the process and costs.

During this whole time frame, my wife was having her right knee replaced and I was undergoing seven rotator cuff surgeries on both shoulders. After me and my wife's medical conditions and financial condition as a result of the medical problems had cleared, I sought the advice of a different patent attorney, Mr. Stephen Nipper. Mr. Nipper looked over all of the previous paperwork originated by Mr. Pedersen and explained to me the consequences of letting my application go abandoned. Until then, I was under the impression that I could resume the process of patenting my product at any time.

My previous attorney, Mr. Pedersen, never once explained to me the appeal or abandonment process. I had no idea that once you started a patent process that it had to be completed to the end in a timely fashion. That to me doesn't seem right, but regardless, I should have been informed of the "rules" before I started playing the game otherwise there is no way to win.

Sincerely,



Tom Tomlin

11/13/03

PATENT AND TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: TOMLIN, Tom L.

Group/Art Unit: 3632

Application No.: 10/046,948

Examiner: BRANN, Deborah M.
USPTO - L. B. S. A. R.
CFOC

Filed: 01/14/2002

Attorney Docket No: TOMT101

Title: Trash Bag Support and Liner

RESPONSE TO EXAMINER'S ACTION
dated: 10/09/2002

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

In response to the Examiner's Action mailed October 9, 2002, please enter the following amendments and remarks of record:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this Response to Office Action.

Remarks/Arguments begin on page 3 of this Response to Office Action.

AMENDMENTS

This listing of claims will replace all prior versions, and listings, of claims in the application.

Listing of Claims:US PATENT AND TRADEMARK
OFFICE

1. (Currently Amended) A trash bag support and liner, comprising: a single, generally rectangular piece of plastic, and a temporary locking mechanism configured to be engaged for holding the bag support and liner in a set cylindrical position when a bag is installed upon said bag support and liner, the locking mechanism comprising a tab integral with the single piece of plastic, and a cooperating open slit in the single piece of plastic, wherein said locking mechanism tab is configured to be disengaged from said slit thereby releasing said bag support and liner from said set cylindrical position after said bag is installed upon said bag support and liner.
2. (Original) The bag support and liner of claim 1 which also comprises a hand hole near an edge of the piece of plastic.
3. (Original) The bag support and liner of claim 1 which also comprises hand holes near two edges of the piece of plastic.
4. (Original) The bag support and liner of claim 1 wherein the locking mechanism tab is near an edge of the piece of plastic, and the cooperating slit is near the center of the piece of plastic.

REMARKS/ARGUMENTS*Claim Rejections - 35 USC §102*

CITE PEP 103 104 105 106

1. The Examiner rejected claims 1, 2, and 4 under §102(b) as being anticipated by Benson.
2. Applicant has amended claim 1 to more clearly state how the elements of the claimed embodiment are used. These elements are not shown in the prior art. Support for these amendments can be found on page 2, ll. 24-28 of the application.
3. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
4. Claim 1 has been amended to include the limitation that the bag support and liner be configured with a locking mechanism that engages and disengages when in use, whereby the locking mechanism would be engaged, the bag would be slid over the bag support, and then the locking mechanism would be disengaged, thereby causing the liner to expand and conform to the shape of the bag. Benson does not show this structure. Benson further teaches away from this structure in providing adjustable locking tabs allowing the liner to be configured for use with various shapes and sizes of bags and to conform to the mouth of such a bag. No mention in Benson is made of releasing the tube after being made. For this reason, Benson does not anticipate the present invention in claim 1 or any of the claims that depend there from.

Claim Rejections - 35 USC §103

5. The Examiner rejected claim 3 under §103(a) as being unpatentable (obvious) over Benson in view of Monahan.
6. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).
7. It is submitted that the combination of Benson and Monahan is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of

features recited in applicant's claims. In particular, the references do not disclose, teach, or suggest Applicant's locking means which is engaged when the bag is installed, but disengaged and expands after the bag is installed.

8. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

9. This can be illustrated as why a device that is intended to be utilized when formed as a tube (Benson) would be combined piecemeal with a device intended to be utilized when unrolled (Monaham). These two patents teach away from each other.

10. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicant's specification.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has stated previously that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

In re Fritch, 972 F.2d 1260, 23 USPT2d 1780, 1784 (Fed.Cir. 1992), (in part quoting from *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

11. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore &*

Assoc. v. Garlock, Inc. 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.

Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). That is exactly what the Examiner is doing here.

12. Benson and Monahan are complete and functional without the need for modification. Absent the need for modification to provide functionality, the references could never lead one to make modifications to meet the claims.

13. The initial burden is on the Examiner to provide some **suggestion** of the desirability of doing what the inventor has done.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly *suggest* the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

Ex Parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. and Inter. 1985). MPEP § 706.02(j) (emphasis added).

14. This suggestion for modification must be **motivating**.

"The prior art must provide one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound."

In re Jones, 21 USPQ2d 1941, 1944 (Fed. Cir. 1992) (emphasis added).

15. Even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggest the desirability for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) ("mere fact that prior art may be modified to reflect features of claimed invention does not make the modification, and hence, the claimed invention, obvious unless the desirability of such a modification is suggested by prior art). Citing *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127.

16. Moreover, the motivating suggestion must also be **explicit**. An invention cannot be found obvious unless there is "some explicit teaching or suggestion in art to motivate one of even ordinary skill to combine such elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998).

17. The Examiner's suggested combination is not explicit, nor is it motivated, suggested, or even desirable. No *prima facie* case of obviousness has been made.

18. Benson is clear that the locking means is intended to lock the opener into a fixed shape for use. Otherwise there would be no reason to provide for adjustability in allowing the opener to be locked into a desired circumference. Additionally, Benson is clear that the opener is in "cylindrical form and so retained in locked snugly conforming position during the filling thereof." These two references clearly teach away from one another.

Conclusion

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 14th day of November 2003.

Very respectfully,

STEPHEN M. NIPPER
Reg. No. 46,260
(208) 345-1122

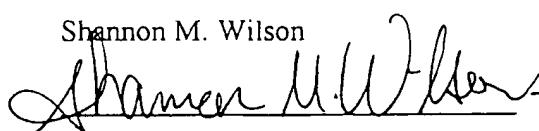
CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DATE: 11/17/03

Shannon M. Wilson



PATENT AND TRADEMARK OFFICE

PTO/SB/61 (09-03)
Approved for use through 07/31/2006. OMB 0551-0031
Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)		Docket Number (Optional) TOM T101
First Named Inventor: TOMLIN, Tom L.	Art Unit: 3632	
Application Number: 10/046,948	Examiner: BRANN, DEBORAH M.	
Filed: 01/14/2002		
Title: Trash Bag Support and Liner		
<p>Attention: Office of Petitions Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p>		
<p>NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703)305-9382.</p>		
<p>The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.</p>		
<p>APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION</p>		
<p>NOTE: A grantable petition requires the following items:</p>		
<ul style="list-style-type: none"> (1) Petition fee; (2) Reply and/or issue fee; (3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8, 1995, and for all design applications; and (4) Adequate showing of the cause of unavoidable delay 		
<p>1. Petition fee</p>		
<p><input checked="" type="checkbox"/> Small entity - fee \$ <u>110.00</u> (37 CFR 1.17(l)) Applicant claims small entity status.. See 37 CFR 1.27.</p>		
<p><input type="checkbox"/> Other than small entity - fee \$ _____ (37 CFR 1.17(l)).</p>		
<p>2. Reply and/or fee</p>		
<p>A. The reply and/or fee to the above-noted Office action in the form of <u>Response to Office Action dated 10/09/2002</u> (identify the type of reply):</p>		
<p><input type="checkbox"/> has been filed previously on _____.</p>		
<p><input checked="" type="checkbox"/> is enclosed herewith.</p>		
<p>B. The issue fee of \$ _____</p>		
<p><input type="checkbox"/> has been paid previously on _____.</p>		
<p><input type="checkbox"/> is enclosed herewith.</p>		

(Page 1 of 3)

This collection of information is required by 37 CFR 1.137(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing the burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)	Docket Number (Optional) TOMT101
--	-------------------------------------

3. Terminal disclaimer with disclaimer fee

- Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ a small entity of \$ _____ or than a small entity) disclaiming the required period of time enclosed herewith (see PTO/SB/63).

4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorize on PTO-2038.

11/14/03

Date

Signature

(208) 345-1122

Telephone Number:

STEPHEN M. NIPPER

Typed or printed name

46260

Registration Number, if applicable

P.O. Box 877

Address

Boise, Idaho 83702

Address

Enclosures: Fee Payment Reply Terminal Disclaimer Form Additional sheets containing statements establishing unavoidable delay

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
- transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

11/17/03

Date

Signature

Shannon M. Wilson

Typed or printed name of person signing certificate

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

US Patent and Trademark Office

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.

11/14/03

Date

Signature

46260

Registration Number, if applicable

STEPHEN M. NIPPER

Typed or printed name

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply.)

Please see the attached statements of the inventor (Tom Tomlin) and his current patent attorney (Stephen M. Nipper).

(Please attach additional sheets if additional space is necessary)

PATENT AND TRADEMARK OFFICE

REGISTRATION NUMBER
10/046,948

US PATENT AND TRADEMARK
OFFICE

Petition for Revival of an Application for Patent Abandoned
Unavoidably..., Response to Office Action dated 10/09/02,
Letter from Stephen M. Nipper, Doc. Entitled "Reasons
Why My Patent Application Went Abandoned", Reasons
Transmittal letter with Certificate of Mailing by First Class
Mail, Check in the amount of \$110, Power of Attorney,
Revocation of Power of Attorney,

Inventor: TOMLIN

Ser. No.: 10/046,948

Invention: TRASH BAG SUPPORT WITH LINER

Our File: TOMT101

Date: November 17, 2003

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY..., RESPONSE TO OFFICE ACTION DATED 10/09/02,
LETTER FROM STEPHEN M. NIPPER, DOC. ENTITLED "REASONS
WHY MY PATENT APPLICATION WENT ABANDONED", GENERAL
TRANSMITTAL LETTER WITH CERTIFICATE OF MAILING BY FIRST CLASS
MAIL, CHECK IN THE AMOUNT OF \$110

Inventor: TOMLIN

Ser. No.: 10/046,948

Invention: TRASH BAG SUPPORT WITH LINER

Our File: TOMT101

Date: November 14, 2003